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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/333,379	06/15/1999	LEROY G. HAGENBUCH	189405	4050

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EXAMINER

DAY, HERNG DER

ART UNIT PAPER NUMBER

2128

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/333,379

Applicant(s)

HAGENBUCH ET AL.

Examiner

Herng-der Day

Art Unit

2128

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-7,9-26,28-36,38 and 52-87 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-26,28-36,38 and 52-87 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/13/06</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to Applicants' Amendment ("Amendment") to Office Actions dated September 8, 2005, mailed March 8, 2006, and received by PTO March 13, 2006.

1-1. Claims 1-7, 9-26, 28-36, 38, and 52-81 have been amended. Claim 8 has been cancelled. Claims 82-87 have been added. Claims 1-7, 9-26, 28-36, 38, and 52-87 are pending.

1-2. Claims 1-7, 9-26, 28-36, 38, and 52-87 have been examined and rejected.

1-3. The indicated allowability of claim 68 is withdrawn in view of the newly discovered issues related to the rejections under 35 U.S.C. 102, as detailed in sections 4 to 4-14 below.

### ***Drawings***

2. The drawings received by on March 13, 2006, are objected to for the following reasons. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the Examiner, the Applicants will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2-1. Figures 1-3 and 21-22 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

***Claim Objections***

3. The newly added independent claim 82 sets forth a plurality of elements or steps. Each element or step of the claim should be separated by a line indentation. 37 CFR 1.75(i).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 17, 9-26, 28-36, 38, 52-59, 61-63, 65, 70, 79, and 83 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5-1. Claim 1 recites the limitation “the chassis” in lines 17 and 23 of the claim. There is insufficient antecedent basis for this limitation in the claim.

5-2. Claim 21 recites the limitation “the chassis” in line 9 of the claim. There is insufficient antecedent basis for this limitation in the claim.

5-3. Claim 31 recites the limitation “the chassis” in line 9 of the claim. There is insufficient antecedent basis for this limitation in the claim.

5-4. Claim 52 recites the limitation “the chassis” in line 13 of the claim. There is insufficient antecedent basis for this limitation in the claim.

5-5. Claim 61 recites the limitation “the floor, ... the respective sidewalls ...the body front wall” in lines 2-4 of the claim. There is insufficient antecedent basis for this limitation in the claim.

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**5-6.** Claim 62 recites the limitation “the modeled body” in lines 2-3 of the claim. There is insufficient antecedent basis for this limitation in the claim.

**5-7.** Claim 63 recites the limitation “the modeled body” in lines 2-3 of the claim. There is insufficient antecedent basis for this limitation in the claim.

**5-8.** Claim 65 recites the limitation “the floor, ... the respective sidewalls, ...the container front wall” in the claim. There is insufficient antecedent basis for this limitation in the claim.

**5-9.** Claim 70 recites the limitation “the floor, ... the respective sidewalls ...the container front wall” in lines 3-5 of the claim. There is insufficient antecedent basis for this limitation in the claim.

**5-10.** Claim 79 recites the limitation “the floor, ... the respective sidewalls ...the body front wall” in lines 3-4 of the claim. There is insufficient antecedent basis for this limitation in the claim.

**5-11.** Claim 83 recites the limitation “the truck body” in line 3 of the claim. There is insufficient antecedent basis for this limitation in the claim.

**5-12.** Claims not specifically rejected above are rejected as being dependent on a rejected claim.

### ***Claim Rejections - 35 USC § 102***

**6.** The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an

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international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 78-81 are rejected under 35 U.S.C. 102(e) as being anticipated by Hagenbuch, U.S. Patent 5,887,914 issued March 30, 1999.

7-1. Regarding claim 78, Hagenbuch discloses a body of a haulage vehicle made by a process comprising:

(a) modeling a shape of a load of heaped material in three dimensions, where the shape is substantially conical and the modeling incorporates information about angles of repose for a particular heaped material to be hauled by the vehicle (FIG. 10B, loaded 2:1 heap);

(b) modeling a body to hold the substantially conically shaped load of the material, where a shape of the body is defined by predetermined parameters (FIG. 10A); and

(c) producing the body according to values of the predetermined parameters resulting from the modeling of the body (FIG. 14A and 14B).

7-2. Regarding claim 79, Hagenbuch further discloses the predetermined parameters include one or more of (1) a position of the body's floor, (2) a position of the body's sidewalls (3) a length of the floor, (4) a height of sidewalls, (5) a distance between the respective sidewalls and (6) a position of the body front wall (for example, FIG. 9A, body floor line).

7-3. Regarding claim 80, Hagenbuch further discloses adjusting the predetermined parameters to locate a center of gravity of material held in the modeled body that approximates a lowest possible location (FIG. 14B, step 8e).

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7-4. Regarding claim 81, Hagenbuch further discloses adjusting the predetermined parameters to allow material to be loaded into the modeled body from a lowest practical vertical elevation over a floor of the body (FIG. 14A, step 3, minimum distance above chassis).

8. Claims 1-7, 9-26, 28-36, 38, and 52-87 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hagenbuch, U.S. Patent 5,887,914 issued March 30, 1999.

8-1. All the independent claims 1, 21, 31, 52, 60, 64, 68, 73, 78, and 82 are Product-by-process claims and directed to a body or a container. They are anticipated by the load-carrying body disclosed by Hagenbuch in U.S. Patent 5,887,914 issued March 30, 1999.

The courts have held that “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Furthermore, “[T]he lack of physical description in a product-by-process claim makes determination of the patentability of the claim more difficult, since in spite of the fact that the claim may recite only process limitations, it is the patentability of the product claimed and not of the recited process steps which must be established. We are therefore of the opinion that when the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim, a rejection based alternatively on either section 102 or section 103 of the statute is eminently fair and acceptable. As a practical matter, the Patent Office is not

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equipped to manufacture products by the myriad of processes put before it and then obtain prior art products and make physical comparisons therewith.” In re Brown, 459 F.2d 531, 535, 173 USPQ 685, 688 (CCPA 1972). All the dependent claims are process claims, however, they have not changed the product structure. Therefore, all the dependent claims are also obvious by the load-carrying body disclosed by Hagenbuch in U.S. Patent 5,887,914 issued March 30, 1999.

### *Applicants' Arguments*

9. Applicants argue the following:

#### 9-1. THE SECTION 112 REJECTIONS OF PARAGRAPH 4

(1) “it was agreed that further examination would not result in the rejection of the claims for missing an ‘essential element’ simply because of their scope.” (Page 19, paragraph 2, Amendment).

(2) “All of these lack-of-antecedent-basis rejections have been addressed and overcome by appropriate amendments to the claims in this response.” (Page 20, paragraph 4, Amendment).

#### 9-2. THE PRIOR ART REJECTIONS

(3) “applicant has amended claim 78 to expressly require ‘modeling a shape of a load of heaped material in three dimensions, where the shape is substantially conical and the modeling incorporates information about angles of repose in three dimensions for a particular heaped material to be hauled by the vehicle’.” (Page 20, paragraph 6, through page 21, paragraph 1, Amendment).



(4) “Claim 78 requires modeling a load based on information obtained about the heaping characteristics of ‘a particular material to be hauled by the vehicle.’” (Page 21, paragraph 1, Amendment).

**9-3. CORRECTED DRAWINGS REQUIREMENT**

(5) “Figures 1-3, 21 and 22 support text describing the process of designing a body according to a detailed embodiment of the invention. Labeling these drawings ‘prior art’ as proposed by the Office action would suggest aspects of the design process referencing the drawings are in the prior art, which they are not.” (Page 21, paragraph 2, Amendment).

***Response to Arguments***

**10.** Applicants’ arguments have been fully considered.

**10-1.** Applicants’ arguments (1) - (2) are persuasive. The rejections of claims 1-26, 28-36, 38, 52-67, and 69-77 under 35 U.S.C. 112, second paragraph, in Office Action dated September 8, 2005, have been withdrawn.

**10-2.** Applicants’ arguments (3) - (4) are not persuasive. Because the shape is substantially conical the information about ‘angles of repose’ will be substantially identical in either three dimensions or two dimensions. Furthermore, when the particular heaped material has the characteristics of, for example, a 2:1 heap, which has not been excluded from the claim, the prior art meets the claimed limitations.

**10-3.** Applicants’ argument (5) is not persuasive. Figures 1-3 illustrate steps 2-4, which have been disclosed and taught in U.S. Patent No. 5,887, 914. Figures 21 and 22 show an existing

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loaded off-highway truck. Applicants are encouraged to particularly point out the subject matter which applicant regards as the instant invention for those existing loaded off-highway trucks.

***Conclusion***

11. Applicants' amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Herng-der Day whose telephone number is (571) 272-3777. The Examiner can normally be reached on 9:00 - 17:30.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2100 Group receptionist: (571) 272-2100.

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If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kamini S. Shah can be reached on (571) 272-2279. The fax phone numbers for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Herng-der Day

July 10, 2006 *H.D.*

*Thay Phan*  
*Thau Phan*  
*Patent Examiner*  
*Art. 2128*